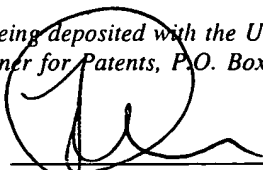




PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 22, 2005.

  
Robert J. Lorch

Appl No. : 09/788,069  
Applicant : Seth Weisberg et al  
Filed : February 16, 2001  
Title : On-Line Value-Bearing Indiciu Printing Using DSA

Confirmation No. 5093

TC/A.U. : 3621  
Examiner : Firmin Backer

Docket No. : 41232/SAH/S850  
Customer No. : 23363

**ARGUMENTS IN SUPPORT OF THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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Pasadena, CA 91109-7068  
December 22, 2005

Commissioner:

In support of the Pre-Appeal Brief Request for Review submitted herewith, the Applicant requests review for the following reasons:

I. The Examiner has committed a clear error in asserting that U.S. Patent Number 6,233,565 issued to Lewis ("Lewis") teaches each of the elements of claims 1-37.

II. The Examiner has committed a clear error in failing to acknowledge the addition of claims 38-41 to the application.

## **ARGUMENTS**

### **I. Failure to Establish that Cited References Teach each Element of the Claims**

The Examiner has rejected claims 1-37, including each of the independent claims, 1, 12, 19 and 30, as anticipated under 35 U.S.C. § 102 based on Lewis. Applicants believe the Examiner has clearly failed to establish anticipation.

To establish anticipation the Examiner must show that the cited reference teaches each of the elements of the claim. In regard to the independent claim 1, this claim is for a "method of printing a value bearing indicium" involving "stateless cryptomodules," "each stateless cryptomodule being programmable to service any of the plurality of remotely located user computers." Independent claims 12, 19 and 30 include similar elements of "the stateless cryptomodule being one of a plurality of stateless cryptomodules, each stateless cryptomodule programmable to service any remotely located user computer," "each stateless cryptomodule being programmable to service any of the plurality of user computers" and "each stateless cryptomodule being programmable to service any of the plurality of remotely located user computers," respectively. The Examiner asserts that Lewis teaches these elements of claims 1, 12, 19 and 30, stating "see figs 1-3 and their accompanying text." Applicants have reviewed these figures and the accompanying section of Lewis, but have been unable to discern any support for the Examiner's assertion. Rather, Lewis discloses a system where there is a one to one relationship between users and postal security devices (PSDs). The server of Lewis "maintains a separate PSD 20n (indicated by a letter subscript 'n') for each registered customer. See Lewis, col. 6, lines 60-63 and col. 27, lines 47-54. Thus, Lewis does not teach a system where any PSD may be used to service any other user. Instead, a user must log into or connect to a specific PSD. Therefore, Lewis does not teach each of the elements of these claims.

Further, this issue has been discussed with the Examiner during the July 26, 2005 Interview related to this case as well as other cases, with specific reference to Lewis. The subject matter of the amendments to the claims submitted in the response mailed August 8, 2005

was discussed with the Examiner during this interview, in which the Examiner indicated that the references cited in this case and other cases, including Lewis did not teach these elements.

Accordingly, Applicants believe that the Examiner has failed to establish that Lewis teaches each of the elements of independent claims 1, 12, 19 and 30. Claims 2-11, 13-18, 20-29 and 31-37, depend from these claims, respectively, and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to the independent claims, these claims are not anticipated by Lewis.

Applicants believe for the reasons set forth above, that the Examiner has made a clear error in failing to establish anticipation of claims 1-37.

## **II. Failure to Acknowledge New Claims**

Further, Applicant believes the Examiner has committed a clear error in failing to acknowledge and enter new claims 38-41, submitted in the response to Office action mailed August 8, 2005. The Examiner does not note these claims in the disposition of claims of the Office action summary for the Office action mailed October 21, 2005. No mention is made in the remainder of the Office action to justify the exclusion of these claims or indicate that the claims would not be entered. Applicants presume that the Examiner overlooked these new claims and that the failure to examine these claims was inadvertent. These claims were submitted in response to a non-final Office action and should have been entered. This constitutes a clear error on the part of the Examiner.

Further, the Examiner has not asserted any grounds for rejecting these claims. Each of these claims is a dependent claim, depending from claims 1, 12, 19 and 30, respectively. Thus, at least for the reasons mentioned in regard to the independent claims, these claims are not anticipated or obvious over Lewis.

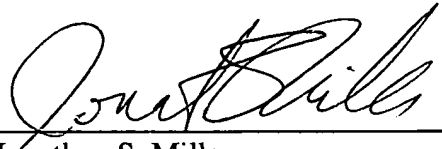
**Appln No. 09/788,069**

For these reasons, the Applicants respectfully request the review of the present application prior to the submission of an appeal brief.

Respectfully submitted,

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